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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,333	05/24/2005	Edith Dellacherie	122536	8802

25944 7590 10/28/2010  
OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA, VA 22320-4850

EXAMINER
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PALENIK, JEFFREY T

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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10/28/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarnstrong@oliff.com

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/522,333

**Applicant(s)**

DELLACHERIE ET AL.

**Examiner**

Jeffrey T. Palenik

**Art Unit**

1615

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
b) ☐ They raise the issue of new matter (see NOTE below);  
c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-7, 9-20 and 28-33

Claim(s) withdrawn from consideration: 8 and 21-24

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

/Jeffrey T. Palenik/  
Examiner, Art Unit 1615

/Robert A. Wax/  
Supervisory Patent Examiner  
Art Unit 1615

Continuation of 3. NOTE: Applicants' amendments, were they to be entered on the record would require further consideration and search on the part of the Examiner. Concerning the amendment made in claim 1 where Applicants recite that "said amphiphilic hyaluronan is used as [an] emulsion stabilizing agent during the production of the particle by emulsion/solvent techniques", the Examiner considers this to raise new issues under 35 USC 112. First, the product-by-process limitation of "production of the particle by emulsion/solvent techniques" is indefinite on the grounds that the limitations recite no steps which further limit the method used. Second, the amendment is considered as raising issues related to the scope of enablement of the "techniques" recited. Applicants assert that their method is the only means through which the instant particle is achieved, yet the scope of the claim does not appear to be commensurate with this claim. That is to say the scope of the claimed techniques available to achieve the claimed particle appears to be broader than that which is supported in the instant disclosure (i.e., the claim implies a multitude of useable emulsion/solvent evaporation techniques).

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' amendments, were they to be entered on the record would require further consideration and search on the part of the Examiner. Concerning the amendment made in claim 1 where Applicants recite that "said amphiphilic hyaluronan is used as [an] emulsion stabilizing agent during the production of the particle by emulsion/solvent techniques", the Examiner considers this to raise new issues under 35 USC 112. First, the product-by-process limitation of "production of the particle by emulsion/solvent techniques" is indefinite on the grounds that the limitations recite no steps which further limit the method used. Second, the amendment is considered as raising issues related to the scope of enablement of the "techniques" recited. Applicants assert that their method is the only means through which the instant particle is achieved, yet the scope of the claim does not appear to be commensurate with this claim. That is to say the scope of the claimed techniques available to achieve the claimed particle appears to be broader than that which is supported in the instant disclosure (i.e., the claim implies a multitude of useable emulsion/solvent evaporation techniques). Further concerning the portion of the newly added recitation stating wherein "the amphiphilic hyaluronan is used as [an] emulsion stabilizing agent", said recitation is considered to be one of intended use concerning a component which has already been shown to be present by the rejection of record. Concerning the amendment made to claims 1 and 32 removing the phrase "at least in part", it does not appear that the scope of this limitation has been changed. That is to say, the molecular interaction between the two phases is still considered to read on this portion of the claim. Concerning the subsequent rejections made under 35 USC 103 combining the Illum reference with either della Valle and McMurphy or with Lee, Applicants provide no arguments beyond that which is stated on behalf of the rejection over Illum alone.